

REMARKS

I. Claim Amendments

The Examiner stated that claims 1-3, 6-7, 10-12, 14-16 and 18 contain phrases that use the terms "can", "may" or both followed by some function. The Examiner argued that the use of the terms "can" and "may" does not positively claim the function, therefore, these phrases are not given patentable weight. The Examiner advised the Applicant to review the claims to ensure that the claims are written so as to ensure patentable weight is given to the claims.

The Applicant notes that claims 1-3, 6-7, 10-12, 14-16 and 18 have been amended in response to the Examiner's statement. The Applicant submits that these claims positively claim the limitations as now amended.

II. Claim Rejections - 35 USC § 103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices

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according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.”

“To facilitate review, this analysis should be made explicit.”

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. *a reasonable expectation of success; and*
2. *the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).*

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Lundgren in view of Marsh and Ross

The Examiner rejected claims 1-11 and 13-20 under 35 U.S.C. §103(a) as being unpatentable over Lundgren (U.S. Patent Application No. 2003/0048471) in view of Marsh (U.S. Patent Application No. 2002/0061238) in view of Ross (U.S. Patent Publ. No. 5,465,213).

Regarding claims 1-11 and 13-20, the Examiner argued that Lundgren discloses providing aircraft passengers (i.e., travelers) with Internet access (citing Lundgren paragraph [0003]) whereby a “laptop computer or handheld computer” is connected “to an Internet web site for accessing a printing management application” where printing is performed “at a designated airport or at other

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locations designated by the user" (citing Lundgren paragraph [0007]). The Examiner argued that when selecting the printing and delivery options, including printing to printers at airports, the traveler is able to electronically select production facilities near the traveler's destination (citing Lundgren paragraph [0018]). The Examiner argued that the document is printed at the location specified by the traveler and is picked up "at the airport after the aircraft has landed" (citing Lundgren paragraph [0020]), thus the document is distributed to a pick-up facility as chosen by the traveler. The Examiner argued that Lundgren discloses that documents can be reviewed from the Internet (citing Lundgren paragraph [0004]). The Examiner argued that in this regard, it is obvious that documents that are reviewed from the Internet include previously published works, i.e., *publications*. The Examiner argued that therefore, publications are ordered from the Internet when the traveler provides user ID and billing information to the printing services application (citing Lundgren paragraph [0018]). The Examiner argued that Lundgren further discloses requiring "user identification (ID) and account information, including billing information such as a credit card number" be provided to the printing services application. The Examiner argued that this information is used to "track any print job initiated through the printing services application" (citing Lundgren paragraph [0018]). The Examiner stated that it is obvious that upon pick-up of the selection, the traveler's identity would be authenticated in that the print order would be matched against the user ID and the billing information provided by the traveler when the selection was ordered. The Examiner argued that a remote pick-up location would be motivated to verify customer IDs and account information to ensure that print orders are released to the customer who ordered it. The Examiner argued that by teaching a system where on-board and remote printing operations of documents on the Internet (citing Lundgren paragraph [0004]) are performed for a fee, printing on demand is performed.

The Examiner admitted that Lundgren does not disclose *a catalog from which publications can be selected* or that the print on demand system prints a

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publication cover and binds the publication block of the selection from the catalog. The Examiner argued that Lundgren does disclose Internet access during a flight where travelers can access Internet services. The Examiner stated that this disclosure of Internet access during a flight obviously includes access to web based businesses.

The Examiner argued that Marsh discloses an online system for ordering and printing books on demand in which customers access via the Internet to view the books in the digital library (i.e., preview the books in a catalog or database), select and order the book and command the book to be printed, bound and trimmed (citing Marsh paragraph [0112]). The Examiner argued that Marsh also points to U.S. Patent No. 5,465,213 (Ross) as providing the teaching for accessing via the Internet to order a book to be printed on demand (citing Marsh paragraph [0112]).

The Examiner argued that therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included selecting and previewing publications to be printed from an online catalog, as disclosed by Marsh in the system disclosed by Lundgren, for the motivation of providing a convenient means of shopping. The Examiner stated that catalogs are an old and well known form of perusing items available for purchase that affords the customer convenience. The Examiner argued that by having provided Internet access to airline passengers, Lundgren foresaw the use of Internet shopping, and therefore, the obvious need for catalogs (citing Lundgren; paragraph [0003]: the system offers "Internet services while in-flight"). The Examiner argued that therefore, ordering anything from the Internet, including books to be printed on demand, is an obvious expansion of Lundgren's system.

The Examiner argued that Ross discloses a kiosk based system where a customer views "promotional sales information" (i.e., a catalog), purchases the book through system which initiates printing of the book and cover and finally binding (citing Ross col. 1; lines 55-C2; and line 32). The Examiner argued that Ross discloses that the "floor space required for the book manufacturing system...is

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somewhat larger than an ordinary office desk..." (citing Ross col. 2; lines 57-59). The Examiner argued that Ross also discloses using a WAN for a user to select a book where the WAN includes "satellite communications" (citing Ross col. 12; lines 38-56).

The Examiner argued that therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have expanded the system of Lundgren to include the print on demand system of Ross/Marsh wherein a book is ordered via the Internet and printed and bound with a cover since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The Examiner argued that specifically, it is predictable that the system of Lundgren, which discloses ordering and purchasing printed documents, when expanded to include the automatic thermal binding machine which is used to bind the text pages into the cover (citing Ross; col. 2; lines 27-29), would still perform the function of printing ordered documents. The Examiner argued that as the floor space requirements for the entire book manufacturing system of Ross is "somewhat larger than an ordinary office desk", it is obvious that the system of Lundgren would be capable of the expansion to include the added binding machine.

The Examiner admitted that Lundgren, Marsh and Ross do not disclose that the catalog can be made available in printed form; however, the Examiner argued that it is obvious that airlines provide in-flight catalogs such as "SkyMall". The Examiner argued therefore that it is obvious to expand the combined system of Lundgren/Marsh/Ross to include a printed catalog. The Examiner argued that one would be motivated to do so in order to minimize both the cost of the in-flight internet access and the use of the laptop battery. The Examiner argued that by providing a printed catalog, the traveler is able to leisurely peruse the selections available then connect to the internet just to make the purchase.

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The Applicant respectfully disagrees with this assessment and notes that the Applicant's invention as claimed is the innovation wherein a traveler connects and gains access to a print on demand system capable of printing books stored in a database of the print on demand system. The problem the Applicant's invention solves which is not solved by Lundgren in view of Marsh and Ross is that there is a limited stock of books and reading material in airport/terminal shops wherein the traveler spends a considerable amount of time in the terminal area or en-route. The Applicant's innovation is that the *traveler* is given access to the print on demand system from either *on-board a vessel* or in a *terminal waiting area* (the non-productive time during travel) and the publication is printed and *waiting* for the traveler upon disembarking. The prior art of Lundgren in view of Marsh and Ross does not disclose this innovative aspect of the Applicant's invention. Claims 13 and 18 have been amended to include "automatically producing a publication ordered from public transport facilities while traveling to a traveler's destination" in the claim preamble in order to positively claim this innovative aspect of the Applicant's invention.

Additionally, the Examiner has argued that Lundgren discloses a print on demand system arguing "that by teaching a system where on-board and remote printing operations of documents on the Internet are performed for a fee, printing on demand is performed". The Applicant submits however that this is not the definition of a print on demand system, as disclosed in the Applicant's paragraph [0003], as follows:

"The present inventor recognized the potential for distribution of published material in the traveling marketplace because of his knowledge in the field of on-demand publishing. On-demand publishing has come about in recent years because vast technological advancements in the photocopier equipment industry enable more flexible offset-quality production. Xerox Corporation, for example, offers hardware and software for the on-demand publishing marketplace. On-demand publishing technology enables publishers to print books in short run lengths on demand, at a reasonable costs. Publishers save money on warehousing, returns, and the production of intrinsically short run books (comps, review copies, sales samples, etc.) They also realize new business opportunities from out-of-print books and never-in-print books."

Furthermore, a quick search of the term “print on demand” or “on demand publishing” (for example, Wikipedia) shows that print on demand refers to a process in which new copies of books are not printed until an order is received. The printed book therein ordered includes the book cover and book block. Therefore, remote printing for a fee over the internet does not constitute “print on demand”.

Lundgren discloses a *document* printing system, stating that the alternatives to the Lundgren system would be for a passenger to bring a printer on board the aircraft or for a printer to be provided on board (Lundgren paragraph [0004]). Documents are typically non-published files either on the computer in use itself or downloaded from the internet; i.e. pages. Lundgren does not disclose nor imply that *books* could be printed on the Lundgren system, as the Examiner has pointed out a *print on demand system*, which would be capable of printing books, requires floor space somewhat larger than an ordinary office desk, difficult at best to bring on board an aircraft. Therefore Lundgren does not disclose a print on demand system capable of printing published materials such as books.

The Examiner argued that by Lundgren having provided internet access to airline passengers, Lundgren foresaw the use of internet shopping, and therefore, the obvious need for catalogs. However, the Applicant submits that there is no mention in Lundgren of internet shopping or of catalogs or any evidence that this was foreseen by Lundgren. The Examiner argued that it would be obvious to combine the Lundgren and Marsh references by adding the system of Marsh with a motivation of providing a convenient means of shopping. However, the Applicant submits that there would not be a motivation to combine the Lundgren and Marsh as Lundgren does not disclose a shopping method and system, only a document page printing system. The Examiner’s argument that ordering *anything* on the internet is an obvious expansion of Lundgren is presented without any evidence by the Examiner and is a conclusory statement by the Examiner.

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The Examiner further cites the "SkyMall" catalog currently on board aircraft for the obviousness of a printed catalog; however, the SkyMall catalogs do not include the capability of purchasing items in flight and thereafter picking the item up at the destination and therefore this aspect is not obvious to one of ordinary skill in the art.

The Examiner has argued that it would have been obvious to one of ordinary skill in the art to combine Lundgren in view of Marsh with the Ross reference arguing that in the combination each element would have performed the same function as it did separately. The Applicant notes that the Supreme Court has stated that in the KSR ruling that it remains legally insufficient to conclude that a claim is obvious just because each feature of the claim can be independently shown in the prior art.

Therefore the Applicant submits that Lundgren in view of Marsh and further in view of Ross does not disclose wherein the selection and ordering of publications occurs while the traveler is awaiting travel, en-route on public transportation, or preparing to disembark public transportation wherein the print on demand system performs printing and binding of the at least one publication at the traveler's destination.

Based on the foregoing, the Applicant's submits that Lundgren in view of Marsh and further in view of Ross fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims is not disclosed. Furthermore, the Applicant submits that the combination of the references is not obvious. Therefore, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claim 1-11 and 13-20 based on Lundgren in view of Marsh and Ross be withdrawn.

The Examiner rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Lundgren in view of Marsh, Ross and further in view of PR Newswire ("iUniverse Secures Additional \$18 million in funding", PR Newswire, New York, Oct. 15, 2001, page 1).

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The Examiner admitted that Lundgren in view of Marsh and Ross do not disclose that the publication includes only selected chapters of a book or several publications in a single, bound publication.

The Examiner argued that PR Newswire discloses custom book programs that allow customers to "browse, compile and purchase books compiled from individual chapters of selected Microsoft, Frommer's Cliff Notes and Dummies Guide titles" (citing page 1, paragraph 3).

The Examiner argued therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have included selecting chapters to create a custom book, as directed by PR Newswire, in the system of Lundgren/Marsh/Ross for the motivation of providing content that suits a customer's specific needs. The Examiner argued that it is obvious to order the printing of selected chapters, such as from a travel book, in order to minimize the amount of printed pages that a traveler carries. The Examiner argued that the traveler of Lundgren's system would be motivated to print out only the material that pertains to the sites, hotels or restaurants of interest to him. The Examiner argued that the option to print only the selected chapters provides concise and pertinent information without creating the burden of carrying too much information.

The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejections of claims 1-11 and 13-20 applies equally against dependent claim 12.

Based on the foregoing, the Applicant respectfully request that the 35 U.S.C. §103(a) rejection of claim 12 based on Lundgren in view of Marsh, Ross and PR Newswire be withdrawn.

III. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural

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distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



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